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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,182	10/05/1999	JOSEPH M. CANNON	83-76-31	9312

7590 10/02/2003

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EXAMINER

WEST, LEWIS G

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,182

Applicant(s)

CANNON ET AL.

Examiner

Lewis G. West

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Response to Arguments

1. Applicant's arguments filed July 11, 2003 have been fully considered but they are not persuasive. As previously stated in the advisory action, arguments are based on new matter, because new matter is not allowed and must be removed, all arguments regarding these limitations are moot. Further arguments relating to "on hook" and "off hook" have been addressed multiple times with evidentiary support in the prior art, and are still not persuasive.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1, 6 and 12, and therefore the claims which depend therefrom, have added limitations regarding the reception of a dial tone which are not supported by the specification. All new matter must be removed. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6 and 8-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tendler (US 5,555,286).

Regarding claim 1, Tendler discloses a cordless (cellular) telephone comprising a base unit (cell site), with a telephone line interface to interface the base unit to a public switched telephone network, wherein a handset is adapted to directly communicate to the base station, the handset including a keypad, a key scan element adapted to scan the keypad for a predetermined key sequence while the handset is in an on-hook condition, and a controller adapted to cause the initiation of an outgoing call based on a determination of the predetermined key sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 2, Tendler discloses a cordless telephone wherein the outgoing call is initiated to a telephone number corresponding to the predetermined key sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 3, Tendler discloses a cordless telephone wherein the predetermined sequence is 9-1-1. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 4, Tendler discloses a cordless telephone wherein the base unit is adapted to establish a link with a network based on a signal from the controller in the handset, to sense a dial tone and to output dual tone multifrequency (DTMF) signals corresponding to a number to be dialed to the network. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 6, Tendler discloses a handset for a cordless (cellular) telephone comprising a keypad, a key scan element adapted to scan the keypad for a predetermined key sequence while in an on-hook condition, and a controller adapted to cause the initiation of an outgoing call to a base, directly interfaced to the handset, with a telephone line interface based on a determination of the predetermined key sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 7, Tendler discloses a handset wherein the controller is adapted to output a signal to a corresponding base unit based on the determination of the predetermined key sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 8, Tendler discloses a handset, further comprising an RF transceiver, wherein the signal is output to the base unit via the RF transceiver. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 9, Tendler discloses a handset wherein the signal informs the base unit that the predetermined key sequence has been detected. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 10, Tendler discloses a handset wherein the signal comprises a dialing sequence of a number to be dialed. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 11, Tendler discloses a handset wherein the dialing sequence corresponds to the predetermined key sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 12, Tendler discloses a method of placing a telephone call from a cordless telephone handset, having a telephone line interface, that is in an on-hook condition, comprising the steps of: sensing the activation of a predetermined key sequence and initiating a telephone call based on the sensed activation, wherein the cordless telephone handset is

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adaptively interface directly with the base unit. (col. 7 lines 66- col. 8 line 4) (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 13, Tendler discloses a method wherein the telephone call is a telephone number corresponding to the predetermined key sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 14, Tendler discloses a method wherein the predetermined key sequence is 9-1-1. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 15, Tendler discloses a method wherein the initiating step includes sending a signal to a corresponding base unit. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 16, Tendler discloses a method wherein the signal indicates detection of the predetermined key sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 17, Tendler discloses a method wherein the signal includes a dialing sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 18, Tendler discloses a method wherein the dialing sequence corresponds to the predetermined key sequence. (col. 2 lines 31-45, col. 5 lines 11-26)

Regarding claim 19, Tendler discloses a method wherein the signal is sent via an RF link. (col. 2 lines 31-45, col. 5 lines 11-26)

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tendler et al.

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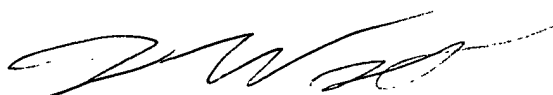
Regarding claim 5, Tendler discloses a device that may be used with a landline network using DTMF. (Col. 8 lines 5-14) Examiner takes official notice that would have been notoriously well known in that art at the time of the invention that a PSTN is a landline network using DTMF. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use the device in connection with a PSTN, because a PSTN is a widespread and standard form of wireline network that uses the DTMF protocol.

Conclusion

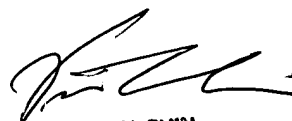
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 703-308-9298. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.



Lewis West
(703) 308-9298
September 25, 2003



VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

9/30/03